

### **REMARKS**

In the June 6, 2005 Office Action, claims 1-19 stand rejected in view of prior art. On the other hand, claims 20-25 were indicated as being allowed. Applicant wishes to thank the Examiner for the indication of allowable subject matter and the thorough examination of this application. No other objections or rejections were made in the Office Action.

#### ***Status of Claims and Amendments***

In response to the June 6, 2005 Office Action, Applicant has amended the claims as indicated above, and cancelled claim 4. Thus, claims 1 and 5-25 are now pending, with claims 1, 13 and 20 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

#### ***Rejections - 35 U.S.C. § 102***

In paragraphs 4-6 of the Office Action, claims 1-5 and 11-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Publication No. US2003/0110880 (hereinafter "the '880 publication"), U.S. Patent No. 3,284,114 (hereinafter "the '114 patent") and/or U.S. Patent No. 4,340,238 (hereinafter "the '238 patent"). Specifically, claims 1-5, 11 and 12 were rejected using the '880 publication, claims 11 and 12 were rejected using the '114 patent, and claims 11-19 were rejected using the '238 patent. In response, Applicant has amended independent claims 1 and 13 to more clearly define the present invention over the prior art of record. Claim 11 (previously independent) has also been amended to place this claim back in dependent form.

In particular, independent claims 1 and 13 as now amended require, *inter alia*, a locking member configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures when the first and second tubular members are located in a plurality of different axial positions relative to each other such that the bicycle headset structure is operable with the first and second tubular members located in the plurality of different axial positions. Also, independent claim 1 has been amended to clarify that the first mating adjustment structure includes a set of first threads, and the second mating adjustment structure includes a set of second threads that are threadedly engaged with

the first threads to prevent axial separation of the first and second mating adjustment structures when the first and second threads are threadedly engaged, and that the locking member is constructed as a separate member from the first and second tubular members that is threadedly coupled to one of the first and second threads such that rotation of the locking member relative to the one of said first and second threads is used in order for the locking member to be selectively set. Independent claim 13 already required a locking member including a split locking collar having an adjustable inner diameter, a first tapered surface that engages the first tubular member, and a second tapered surface that engages the second tubular member, the first and second tapered surfaces being configured and arranged to apply an axial force on the first and second tubular members. These structures of independent claims 1 and 13 are *not* disclosed or suggested by the '880 publication, the '114 patent, the '238 patent, or any other prior art of record. It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference.

Specifically, with respect to independent claim 1, the '880 publication fails to disclose threads that are engaged with each other to prevent axial separation. The Office Action asserts that the '880 publication broadly discloses threads. Applicant disagrees with this assertion, and notes that the position of the Office Action is inconsistent with the dictionary definition of "threads" and the understanding of this term within the bicycle art. However, in any case, Applicant has amended independent claim 1 to better distinguish the '880 patent, by clarifying that the threads *prevent axial separation when threadedly engaged with each other*, which is clearly absent from the arrangement of the '880 publication. Moreover, independent claim 1 now positively recites a locking member threadedly coupled to one of the first and second threads such that rotation of the locking member relative to the one of said first and second threads is used in order for the locking member to be selectively set. This arrangement is also lacking from the '880 publication, especially if the term "threads" and "threadedly coupled" are properly construed. Accordingly, withdrawal of the rejection of independent claim 1 based upon the '880 publication is respectfully requested.

Referring still to independent claim 1, the '238 patent fails to disclose an arrangement where a locking member is configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures when the first and

second tubular members are located in a plurality of different axial positions relative to each other. Rather, in the '238 patent the so-called first and second tubular members can only be set in a single position relative to each other. Moreover, independent claim 1 now positively recites a locking member threadedly coupled to one of the first and second threads such that rotation of the locking member relative to the one of said first and second threads is used in order for the locking member to be selectively set. This arrangement is also lacking from the '238 patent, especially if the term "threads" and "threadedly coupled" are properly construed. The '238 patent discloses a locking member (30) that is not threadedly coupled to other members (i.e. a floating, tapered locking member) that is used to set the so-called first and second tubular members in a single position relative to each other. Accordingly, withdrawal of the rejection of independent claim 1 based upon the '238 patent is respectfully requested.

With respect to claim 11 (previously independent) and claim 12, the '114 patent fails to disclose the unique arrangement of independent claim 1, as now amended. Specifically, the '114 patent fails to disclose an arrangement where a locking member is configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures when the first and second tubular members are located in a plurality of different axial positions relative to each other. Rather, in the '114 patent the so-called first and second tubular members can only be set in a single position relative to each other. Moreover, the '114 patent lacks a locking member threadedly coupled to another member whatsoever. Accordingly, Applicant believes the '114 patent fails to anticipate independent claim 1. Since claims 11 and 12 depend from independent 1, the '114 patent also fails to anticipate these claims, and withdrawal of this rejection is respectfully requested.

Referring now to independent claim 13, the '238 patent fails to disclose an arrangement where a locking member is configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures when the first and second tubular members are located in a plurality of different axial positions relative to each other. Rather, in the '238 patent the so-called first and second tubular members can only be set in a single position relative to each other. Accordingly, withdrawal of the rejection of independent claim 13 based upon the '238 patent is respectfully requested.

Applicant believes that dependent claims 5 and 14-19 are also allowable over the prior art of record in that they depend from independent claim 1 or independent claim 13, and

therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not anticipate independent claim 1 or independent claim 13, neither does the prior art anticipate the dependent claims. Accordingly, Applicant respectfully requests withdrawal of the rejections of these dependent claims.

***Rejections - 35 U.S.C. § 103***

In paragraphs 7 and 8 of the Office Action, claims 1-19 stand rejected under 35 U.S.C. §103(a). Specifically, claims 1-4 and 11-19 stand rejected as being unpatentable over the '114 patent in view of U.S. Patent No. 5,454,281 (hereinafter "the '281 patent"), while claims 1-10 stand rejected as being unpatentable over U.S. Patent No 5,331,864 (hereinafter "the '864 patent") in view of the '281 patent. In response, Applicant respectfully traverses these rejections, especially in view of the Amendments to independent claims 1 and 13. Applicant has amended independent claims 1 and 13 to better distinguish the prior art, as mentioned above, and amended claim 11 to place this claim back in dependent form.

Independent claims 1 and 13 as now amended require, *inter alia*, a locking member configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures when the first and second tubular members are located in a plurality of different axial positions relative to each other such that the bicycle headset structure is operable with the first and second tubular members located in the plurality of different axial positions. Also, independent claim 1 as now amended requires that the first mating adjustment structure includes a set of first threads, and the second mating adjustment structure includes a set of second threads that are threadedly engaged with the first threads to prevent axial separation of the first and second mating adjustment structures when the first and second threads are threadedly engaged, and that the locking member is constructed as a separate member from the first and second tubular members that is threadedly coupled to one of the first and second threads such that rotation of the locking member relative to the one of said first and second threads is used in order for the locking member to be selectively set. Independent claim 13 already required a locking member including a split locking collar having an adjustable inner diameter, a first tapered surface that engages the first tubular member, and a second tapered surface that engages the second

tubular member, the first and second tapered surfaces being configured and arranged to apply an axial force on the first and second tubular members. Clearly these unique arrangements are *not* disclosed or suggested by the '114 patent, the '281 patent or the '864 patent, whether taken alone or in some combination.

Turning initially to the rejections based upon the '114 patent in view of the '281 patent, the Office Action acknowledges neither of these references alone discloses the unique arrangements required by independent claims 1 and 13. However, the Office Action asserts that it would be obvious to combine these references to result in the claimed arrangements. Applicant respectfully disagrees with the Office Action, especially in view of the amendments to independent claims 1 and 13.

The Office Action basically indicates that the '114 patent discloses the claimed structure, except for being mounted between an upper bearing set and a mounting portion. The Office Action then indicates that the '281 patent (the secondary reference) discloses a steering assembly mounted between an upper bearing set and a mounting portion "to provide a steering assembly with minimized wear and loosening on rugged roads when subjected to up and down shocks," Thus, the Office Action asserts that one of ordinary skill in the art would combine the telescoping pole structure of the '114 patent with the steering assembly of the '281 patent to minimize wear and loosening. Applicant disagrees with these assertions.

First, the '114 patent fails to disclose a locking member configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures when the first and second tubular members are located in a plurality of different axial positions relative to each other such that the bicycle headset structure is operable with the first and second tubular members located in the plurality of different axial positions. Rather, the locking member of the '114 patent can only be used to set the other (tubular) members in a single position. Second, while Applicant agrees that the '281 teaches a certain structure that allegedly provides advantages, if the telescoping pole structure of the '114 patent (primary reference) were utilized in a steering assembly such as in the '281 patent, the part(s) of the '281 patent that contribute to the alleged advantages of the structure (i.e. minimized wear and loosening) would have to be (1) completely removed and replaced with elements of the '114 patent in order to result in a functioning device; and/or (2) completely redesigned/reconstructed in order to achieve a functioning device, if even possible. In either

case, such a hypothetical device, if operable, would eliminate the advantages (i.e. minimized wear and loosening) of the '281 patent relied upon in the Office Action as the motivation for combining these references. Thus, combining the structure of the '114 patent with the steering assembly of the '281 patent, if even possible, would destroy the '281 patent for its intended purpose (i.e. eliminate the advantages that the Office Action asserts would motivate one to combine the references). Moreover, such a combination would require impermissible hindsight reasoning using the claims as a blueprint in an attempt to reconstruct the different prior art devices to result in the claimed invention. In other words, there is no objective teaching in the prior art to combine the references as suggested in the Office Action to result in the unique arrangements of the independent claims. Accordingly, one of ordinary skill in the art would not combine the '114 patent with the '281 patent as suggested in the Office Action to result in the unique arrangements of independent claims 1 and 13, especially as now amended..

It is well settled in U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the prior art *suggests* the desirability of the modification. Moreover, if a secondary reference teaches an advantage and this advantage is used as the motivation for combining the secondary reference with another primary reference, the features of the secondary reference contributing to the advantage (used as the motivation) must be present in any hypothetical combination of the secondary reference with the primary reference. Accordingly, the combination of the '114 patent and the '281 patent lacks any suggestion or expectation of success for combining the patents as suggested in the Office Action to create the Applicant's unique arrangements of independent claims 1 and 13. Moreover, Applicant believes that the dependent claims 11, 12 and 14-19 are also allowable over the prior art of record in that they depend from independent claims 1 and 13, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not disclose or suggest the invention as set forth in independent claims 1 and 13, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims. Accordingly, Applicant respectfully requests that the rejection based upon the '114 patent and the '281 patent be withdrawn in view of the above comments and amendments.

Referring now to the rejection of claims 1-10 based upon the '864 patent in view of the '281 patent, the Office Action acknowledges neither of these references alone discloses the unique arrangement required by independent claim 1. However, the Office Action asserts that it would be obvious to combine these references to result in the claimed arrangement. Applicant respectfully disagrees with the Office Action, especially in view of the amendments to independent claim 1.

The Office Action basically indicates that the '864 patent discloses the claimed structure, except for being mounted between an upper bearing set and a mounting portion. The Office Action then asserts that the '281 patent discloses a steering assembly mounted between an upper bearing set and a mounting portion "to provide a steering assembly with minimized wear and loosening on rugged roads when subjected to up and down shocks." Thus, the Office Action asserts that one of ordinary skill in the art would combine the telescoping pole structure of the '864 patent with the steering assembly of the '281 patent to minimize wear and loosening. Applicant disagrees with these assertions.

First, the '864 patent fails to disclose a locking member configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures when the first and second tubular members are located in a plurality of different axial positions relative to each other such that the bicycle headset structure is operable with the first and second tubular members located in the plurality of different axial positions. Rather, the members of the '864 patent must be mounted in a single position in order for the device to be operable. Second, while Applicant agrees that the '281 teaches a certain structure that allegedly provides advantages, if the telescoping pole structure of the '864 patent (primary reference) were utilized in a steering assembly such as in the '281 patent, the part(s) of the '281 patent that lead to the alleged advantages of the structure (i.e. minimized wear and loosening) would have to be (1) completely removed and replaced with elements of the '864 patent in order to result in a functioning device; and/or (2) completely redesigned/reconstructed in order to achieve a functioning device, if even possible. In either case, such a hypothetical device, if operable, would eliminate the advantages (i.e. minimized wear and loosening) of the '281 patent relied upon in the Office Action as the motivation for combining these references. Thus, combining the structure of the '864 patent with the steering assembly of the '281 patent, if even possible, would destroy the '281 patent for its

intended purpose (i.e. eliminate the advantages that the Office Action asserts would motivate one to combine the references). Moreover, such a combination would require impermissible hindsight reasoning using the claims as a blueprint in an attempt to reconstruct the different prior art devices to result in the claimed invention. In other words, there is no objective teaching in the prior art to combine the references as suggested in the Office Action to result in the unique arrangements of the independent claim. Accordingly, one of ordinary skill in the art would not combine the '864 patent with the '281 patent as suggested in the Office Action.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the prior art *suggests* the desirability of the modification. Moreover, if a secondary reference teaches an advantage and this advantage is used as the motivation for combining the secondary reference with another primary reference, the features of the secondary reference contributing to the advantage (used as the motivation) must be present in any hypothetical combination of the secondary reference with the primary reference. Accordingly, the combination of the '864 patent and the '281 patent lacks any suggestion or expectation of success for combining the patents as suggested in the Office Action to create the Applicant's unique arrangement of independent claim 1. Moreover, Applicant believes that the dependent claims 5-10 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not disclose or suggest the invention as set forth in independent claim 1, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims. Accordingly, Applicant respectfully requests that the rejection based upon the '864 patent and the '281 patent be withdrawn in view of the above comments and amendments.

***Prior Art Citation***

In paragraph 9 of the Office Action, prior art made of record was indicated as being considered pertinent to Applicant's disclosure. Applicant believes that these references do not render the claimed invention obvious.

***Allowable Subject Matter***

In paragraph 10 of the Office Action, claims 20-25 were indicated as being allowed. Applicant wishes to thank the Examiner for this indication of allowable subject matter and the thorough examination of this application.

***Conclusion***

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1 and 5-25 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested. If there are any questions regarding this Amendment, please feel free to contact the undersigned.

Respectfully submitted,



Patrick A. Hilsmier  
Reg. No. 46,034

SHINJYU GLOBAL IP COUNSELORS, LLP  
1233 Twentieth Street, NW, Suite 700  
Washington, DC 20036  
(202)-293-0444

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